

Remarks

In view of the following amendments and remarks, favorable reconsideration of the outstanding office action is respectfully requested. Claims 1 – 21 remain in this application.

1. Allowed Claims/Subject Matter

Applicant notes with appreciation the Examiner's allowance of claims 1 – 10 and 12 – 21.

2. § 103 Rejections

The Examiner has rejected claim 11 under 35 U.S.C. § 103 as being unpatentable for obviousness over U.S. Patent No. 6,431,719 to Lau et al. (hereinafter Lau).

Claim 11 is directed to a lamp module for use in an electrical device. The lamp module includes a housing configured to be inserted into the electrical device. A printed circuit board is disposed in the housing. The printed circuit board having disposed thereon lamp circuitry. The lamp circuitry includes at least one light emitting diode and electrical contacts for engaging complementary electrical terminals of the electrical device. The lamp circuitry is configured to energize the at least one light emitting diode when the lamp module is installed in the electrical device. A lens portion is configured to cover the least one light emitting diode.

Lau is directed to a self-contained night light disposed in a housing containing *spaced-apart male AC prongs the mate with an AC socket*. The housing contains an array of differently colored light emitting diodes 30 disposed under a centrally located lens 40. The electronics are spaced apart from the LEDs 30 and lens 40 and disposed in a corner of the housing 20 (See Figure 1).

According to the **MPEP 2143**, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a

reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As argued in the applicant's response to the previous Office Action, the examiner does not provide a prima facie case for obviousness because the cited art does not teach or suggest all the claim limitations. Claim 11 previously recited *a housing configured to be inserted into the electrical device*. Lau does not teach a housing 20 that is inserted into electrical device 80. Instead, Lau discloses a device that has electrical prongs that are inserted into receptacles 70. As such, housing 20 is disposed adjacent to device 80 and, therefore, is not configured to be inserted into electrical device 80.

The Examiner now argues that applicant is giving "too much weight to the word configured." This is not so, and the comment implies that the Examiner has missed the applicant's point – that the recited *housing* itself, and not male prongs, is inserted into the electrical device. Lau simply does not disclose this limitation. Facts are inconvenient things, and the Examiner gets around this fact by insisting that Lau's "*male prong 60*" is the equivalent to the recited "*housing*." A housing, as anyone skilled or unskilled in the art knows, is an enclosure that "houses" device components. A male prong that fits into an electrical outlet, on the other hand, is a piece of copper formed into the shape of a blade. The applicant would like the Examiner to explain how the recited *printed circuit board* could possibly be disposed in Lau's "male prong," in light of another inconvenient fact – that claim 11 recites that a printed circuit board is disposed in the housing. A male prong cannot, in fact, house anything, let alone a printed circuit board.

With regard to the printed circuit board, there is yet another inconvenient fact that the Examiner is ignoring. Claim 11 recites, in part, "*a printed circuit board disposed in the housing, the printed circuit board having...electrical contacts for engaging complementary electrical terminals of the electrical device*." The Examiner avoids this limitation by saying that the recited *printed circuit board* is inherent in Lau. The applicant respectfully disagrees.

“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The Examiner made a conclusory statement alleging that the structure recited above is inherent in Lau, but provides no evidence in support of the allegation. The structure recited in claim 11 is clearly not necessarily present in Lau. The case law clearly states that inherency cannot be established by mere possibilities or probabilities.

The Examiner’s rejection is also improper because she is attempting to use one element in Lau to cover more than one element in claim 11. If, as the Examiner suggests, *male prongs 60* correspond to the recited *housing*, then Lau does not disclose a “*printed circuit board having...electrical contacts for engaging complementary electrical terminals of the electrical device*,” as recited in claim 11. On the other hand, if *male prongs 60* correspond to the recited *electrical contacts*, then the Examiner cannot honestly say that they correspond to the housing as well.

Nonetheless, the applicant has amended claim 11 to work with the Examiner by adding some clarifying language, and hopefully limit the costs associated with continued prosecution. Amended claim 11 is directed to a lamp module for use in *an electrical device* that includes *a lamp module receptacle disposed in the front face of the electrical device*. The applicant also amends claim 11 to recite “*a housing having a form factor conforming to the lamp module receptacle, the housing being configured to be inserted into the lamp receptacle disposed in the front face of the electrical device*.” As noted above, Claim 11, as previously recited, is allowable. Amended claim 11 is allowable for the same reasons. Unlike Lau, the recited lamp module is itself inserted into the electrical device.

As also noted in a previous response, the Examiner does not provide a prima facie case for obviousness because the rejection does not include any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary

skill in the art to modify the Lau reference to arrive at the present invention. The Examiner does not remedy this shortcoming in the instant Office Action. According to the **MPEP 2143**, the Examiner must provide some suggestion or motivation, taken from either the reference itself or from some body of knowledge generally available to one of ordinary skill in the art, to modify the reference. The Examiner has not done so.

In light of the forgoing reasons, claim 11 is allowable under 35 U.S.C. § 103.

3. Conclusion

Based upon the amendment, remarks and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claim 11 and a prompt Notice of Allowance thereon.

Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 50-1546.

Please direct any questions or comments to Daniel P. Malley at (607) 330-4010.

Respectfully submitted,

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